

**REMARKS/ARGUMENTS**

By this Amendment, the reference to "FIG. 21" in the specification has been corrected at page 48 to properly refer to FIG. 23 instead. Support for the correction of this typographical error may be easily noted upon review of FIG. 23 and the discussion at page 48 concerning the information in this figure. Claims 14, 15 and 21 have been amended to recite that each of substituent groups R<sup>8a</sup> and R<sup>8b</sup> is an oxo group. Additional amendments have also been made in these claims to delete the proviso language associated with each of R<sup>8a</sup> and R<sup>8b</sup> since each of these groups may no longer be other than an oxo group. In addition, since R<sup>8a</sup> and R<sup>8b</sup> are now oxo groups, the subscript "t" must be unity. The depiction of "t" in the chemical formulae of claims 14 and 21 has therefore become unnecessary and has been removed from both of these claims to simply the claims language.

Entry of the foregoing amendments is kindly requested in the interest of expediting the prosecution and removing the remaining issues from consideration. In this regard, it is respectfully submitted that the present amendments to the claims do not raise any additional issues requiring further consideration and/or search by the Examiner. As the Examiner will note, the amendments simply remove certain compounds from consideration and do not add any additional features or compounds not previously claimed. The subject matter of the present claims was therefore previously under consideration by the Examiner.

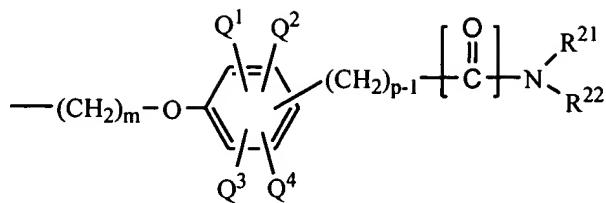
**Double Patenting Rejections:**

Claims 14, 15, 21, 37 and 41 stand rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1-16 of U.S. Patent No. 6,281,205 and claims 7-25 of U.S. Patent No. 6,054,446. Applicants respectfully traverse these rejections for at least the following reasons.

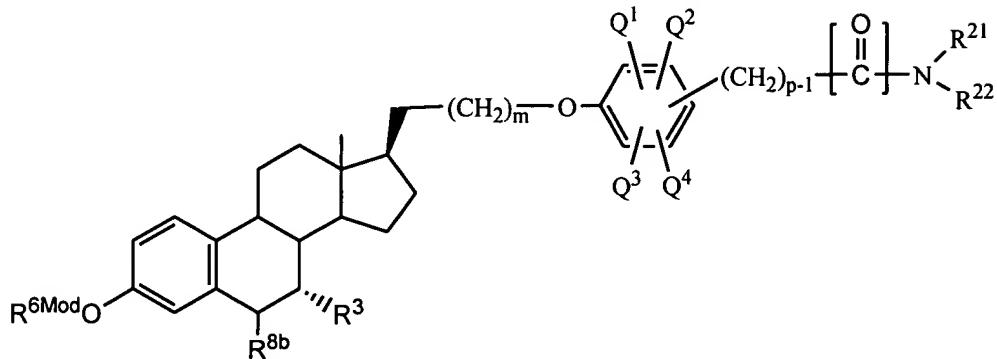
In the outstanding Official Action, the Examiner has commented that the double patenting rejections have been maintained since no terminal disclaimer has been filed. Any confusion created by not filing the terminal disclaimer with applicants' last response is regretted.

Due to the foregoing amendments, however, applicants respectfully submit that the present claims are not properly rejected for double patenting over each of U.S. Patent Nos. 6,281,205 and 6,054,446.

Specifically, the present amendments recite that each of R<sup>8a</sup> and R<sup>8b</sup> is an oxo group. In addition, as noted above, the subscript "t" is unity in the chemical formulae of claims 14 and 21 (although "t" has been deleted for simplicity). In other words, applicants' claims recite that R<sup>20</sup> in the formula of claim 14 may be



while claim 21 recites a compound having the structural formula (VII):



Each of these formulae include the presence of a carbonyl group (i.e., “t” is unity) next to the terminal substituted amino group. The cited claims of each of U.S. Patent Nos. 6,281,205 and 6,054,446, however, do not include such a carbonyl group. Applicants’ claims are therefore not obvious over the cited claims of these patents.

For at least the foregoing reasons, withdrawal of the double patenting rejections is in order and is requested.

#### Rejections Under 35 U.S.C. §102 and/or §103:

Claims 14-16, 18, 21, 37 and 41 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly obvious over Tanabe et al (WO 99/33859). Applicants respectfully traverse these rejections for at least the following reasons.

In the Official Action, it is asserted that Tanabe et al (“Tanabe”) discloses compounds embraced by the present claims. Specific compounds mentioned by the Examiner include the compounds of formula Ib on page 23, formula IIIb on page 25, the compounds listed on pages 32-35 and 37, scheme 16 and compound 79 and scheme 17 and compounds 81, 82, 83 and 84.

Applicants respectfully submit that the present amendments to recite that each of substituent groups  $\text{R}^{8a}$  and  $\text{R}^{8b}$  is an oxo group obviates the rejections based upon Tanabe.

More particularly, Tanabe discloses generic formulae (I), (II) and (III) at pages 17, 20 and 21, respectively, in which the substituent  $\text{R}^8$  is located in the same ring position as applicants’ substituents  $\text{R}^{8a}$  and  $\text{R}^{8b}$ . Tanabe defines  $\text{R}^8$ , however, as being selected from a Markush group “consisting of hydrogen, hydroxyl,  $-\text{NO}_2$ ,  $-\text{CHO}$ ,  $-\text{CH}_2\text{CH}=\text{CH}_2$ ,  $-\text{NR}^{16}\text{R}^{17}$ , and

- $(\text{CH}_2)$  NR<sup>16</sup>R<sup>17</sup> wherein R<sup>16</sup> and R<sup>17</sup> may be the same or different and are either hydrogen, lower alkyl or acetyl". Preferably R<sup>8</sup> is hydrogen.

In stark contrast, applicants' R<sup>8a</sup> and R<sup>8b</sup> substituents are oxo groups. Such substituents are not taught or suggested by Tanabe. No motivation or reason is provided by Tanabe to utilize such oxo substituents, nor is there any apparent discussion of the preparation of compounds according to applicants' claims having such substituents groups. Tanabe therefore fails to anticipate or render *prima facie* obvious applicants' claims.

It is further asserted in the Official Action that because Tanabe teaches certain compounds there would be some reason for the skilled artisan to "prepare additional beneficial compounds for medicinal use". Applicants respectfully disagree that such considerations provide any motivation to modify the invention of Tanabe in some manner to somehow suggest applicants' claims. As noted above, Tanabe quite simply fails to teach the use of, or preparation of, compounds according to applicants' claims having oxo groups located at the position of applicants' substituents R<sup>8a</sup> and R<sup>8b</sup>. Applicants' claims are therefore both novel and non-obvious.

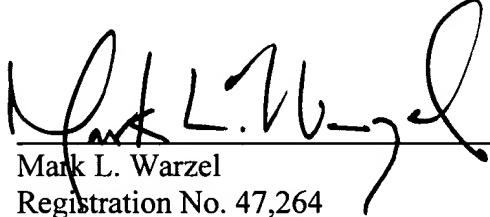
For at least the foregoing reasons, the present claims are patentable over Tanabe et al (WO 99/33859). Withdrawal of the rejections under §§102/103 is requested.

The present application and claims are believed to be in condition for allowance. A notice to that effect is respectfully solicited.

If the Examiner has any questions regarding this Amendment or the application in general, the Examiner is invited to contact the undersigned by phone at 650-330-4908 or by e-mail at warzel@reedpatent.com.

Respectfully submitted,

By:

  
Mark L. Warzel  
Registration No. 47,264

REED & EBERLE LLP  
800 Menlo Avenue, Suite 210  
Menlo Park, California 94025  
(650) 330-0900 Telephone  
(650) 330-0980 Facsimile